REMARKS

<u>Status of the Claims</u>

Claims 1–27 remain pending in the application, Claims 1, 14, and 27 having been amended to more clearly define the present invention.

<u>Claims Rejected under 35 U.S.C. § 112</u>

The Examiner has rejected Claims 1, 14, and 27 under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Specifically, the Examiner asserts that the limitation "an associated content of the palette DO not" should read "an associated content of the palette DOES not," and thus, because of this grammatical error, it is unclear as to what the applicant is trying to convey. Therefore, the Examiner interprets the statement to be a single content of a plurality of the palettes that are displayed on the panel does not obscure viewing of said electronic document.

Applicants respectfully disagree. The claim language is grammatically correct as provided in the Office Action Response filed on October 11, 2004. A verb must agree with its subject in person and number. The Examiner has apparently read these claims so as to view the subject of the phrase objected to as being only "an associated content." However, the subject in this phrase includes not only "an associated content" but also "said palette." A compound subject requires the plural verb in the phrase "do not" instead of the singular verb of "does not." The Examiner should read the claim language correctly as "...such that said palette and an associated content of the palette do not obscure viewing of said electronic document," which means that both the palette and any content that may be associated with the palette do not obscure the electronic document, so as to prevent it being viewed, as shown in FIGURE 5. Palette 502 is shown displayed so that it does not obscure the viewing of content 506. The headings "Alignment and Spacing," "Borders and Shading," and "Document," are for portions of the palette including associated content that has not been activated. In contrast, associated content (such as Style, Name, and Size) under the heading "Font" has been activated and is displayed without obscuring the viewing of content 506 on the screen. It should be understood that the associated content under the heading "Alignment and Spacing" could also be activated and would then be displayed beneath its title of "Alignment and Spacing" without overlaying the viewing of content 506. Accordingly, applicants respectfully request that the Examiner withdraw his rejection of

MS 150899.01
MICR0247-1-1\0247 3-4-05 Amend.doc

Claims 1, 14, and 27 under the second paragraph of 35 U.S.C. § 112, since the position taken by the Examiner is incorrect.

Claims Rejected under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 1-27 as being anticipated by Buxton et al. (U.S. Patent No. 6,469,714, hereinafter "Buxton"). The Examiner asserts that Buxton describes each element of applicants' claimed invention. Applicants respectfully disagree with the rejection for the reasons discussed below.

In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on amended independent Claims 1, 14, and 27. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. However, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

Under "Response to Argument" in the present Office Action, the Examiner disagrees that Buxton fails to teach creating a palette such that the palette and its associated contents do not obscure the viewable content of the electronic document. The Examiner asserts that because applicant only recites a single content of a plurality of the palettes that are displayed on the panel does not obscure viewing of said electronic document, clearly on Figure 3C, the content "Text" does not obscure the display of the electronic document.

Applicants again respectfully disagree. Although "Text" does not obscure the display of the electronic document in Buxton, once "Text" has been activated, as shown by block 330, to display its associated contents named "Font, Alignment, Bullets, Plain Text, Apply Styles, and Manage styles," these contents do indeed obscure desktop 300. Applicants have amended independent Claim 1 in

order to clarify that *both* the palette and its associated contents *when activated* do not obscure the viewing area. Contrary to the Examiner's assertion, applicants' claims do not recite that a single content of a plurality of the palettes that are displayed on the panel does not obscure viewing of said electronic document as the Examiner asserts. Buxton fails to teach or suggest the recitation in these claims of "displaying the palette in conjunction with the electronic document on the user interface such that *said palette and an activated associated content of the palette* do not obscure viewing of said electronic document." (Emphasis added.) Thus, these claims are not anticipated or obvious in view of Buxton.

In addition, applicants have amended independent Claim 1 to clarify how their palette *only* shows controls that are available to be used in conjunction with an electronic document, as compared to Buxton wherein the Action Bar shows controls that are not currently available for use in the electronic document. Thus, amended independent Claim 1 recites "... creating a customized palette for the user interface so that the palette comprises a control *only* for an available property ..." Applicants' specification clearly discloses that a context-sensitive palette or modified palette can include one or more properties, property labels, and controls for each property label, *all of which can be viewed and operated by a user working with the associated electronic document*. Therefore, the user can selectively design the modified palette so that it includes properties, property labels, or controls that are functional or useful to the user. (See applicants' specification, page 25, lines 24-29.) In contrast, instead of reconfiguring the Action Bar when a selection property changes, Buxton simply "dims" a feature on the Action Bar without removing it (Buxton, column 7, lines 60-64). Thus Buxton's Action Bar, unlike applicants' palette, includes dimmed features that are not currently usable. Therefore, Buxton does not anticipate or render obvious applicant's palette that displays only controls for properties that can be affected by the controls.

Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(e) over Buxton should be withdrawn for the reasons given above. Because dependent claims are considered to include all of the elements of the independent claims from which the dependent claims ultimately depend and because Buxton does not disclose or suggest all of the elements of independent Claim 1, the rejection of dependent Claims 2-13 under 35 U.S.C. § 102(e) over Buxton should be withdrawn for at least the same reasons as the rejection of Claim 1.

MS 150899.01
MICR0247-1-1\0247 3-4-05 Amend.doc

With regard to amended independent Claim 14, applicants have also provided further clarification that patentably distinguishes their claimed method over Buxton. Claim 14 is directed to a computer system for providing a selection of formatting properties for an electronic document associated with an application program having a user interface. For the same reasons already noted in regard to Claim 1, amended Claim 14 also distinguishes over Buxton. Accordingly, the rejection of independent Claim 14 under 35 U.S.C. § 102(e) over Buxton should be withdrawn. Because dependent claims are considered to include all of the elements of the independent claims from which the dependent claims ultimately depend, and because Buxton does not disclose or suggest all of the elements of independent Claim 14, the rejection of dependent Claims 15-26 under 35 U.S.C. § 102(e) over Buxton should be withdrawn for at least the same reasons as the rejection of Claim 14.

With regard to amended independent Claim 27, applicants have also clarified the definition of the system that is defined by the claim, so that it clearly implements functions different than those of Buxton. The amendment is consistent with those of Claims 1 and 14. For the same reasons already noted in regard to Claim 1, amended Claim 27 also distinguishes over Buxton. Accordingly, the rejection of independent Claim 27 under 35 U.S.C. § 102(e) over Buxton should be withdrawn.

In view of the amendments and Remarks set forth above, it will be apparent that the claims in this application define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

Ronald M. Anderson
Registration No. 28,829

RMA/SKM:lrg

<u>MAILING CERTIFICATE</u>
I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on March 4, 2005.

Date: March 4, 2005

MS 150899.01
MICR0247-1-1\0247 3-4-05 Amend.doc